

Brief on Appeal to the Board

Docket No.: **KARA-2798US2**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Terry Karanikas

Serial No.: **10/661,445**

Filed: **September 13, 2003**

For: **Wall Unit Forming Method and Apparatus**

Group Art Unit: **3673**

Examiner: **SAFAVI, MICHAEL**

Transmittal of Brief on Appeal

Honorable Commissioner of Patents and Trademarks

Washington, D.C. 20231

Sir:

In compliance with the communication mailed by the Patent Office on January 19, 2007, entitled "Notification of Non-Compliance with the Requirements of 37 CFR 41.37 (c)," submitted concurrently herewith is a new complete Brief.

Brief on Appeal to the Board

Docket No.: **KARA-2798US2**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Terry Karanikas

Serial No.: **10/661,445**

Filed: **September 13, 2003**

For: **Wall Unit Forming Method and Apparatus**

Group Art Unit: **3673**

Examiner: **SAFAVI, MICHAEL**

(i) Real Party in Interest

Terry Karanikas has 100% ownership in the patent application.

(ii) Related appeals and interferences

No related appeals or interferences.

(iii) Status of Claims

Claims 15-21 are the subject of this appeal. No other claims are pending. Claims 1-14 have been previously canceled.

(iv) Status of Amendments

An after final amendment has been filed, but not entered. Applicant argues for the

Serial No.: **10/661,445**

patentability of the entered claims.

(v)Summary of Claimed Subject Matter

A first embodiment according to the present invention is a combination of a wall unit form and a wall formed inside therein according to the present invention is best depicted and exemplified in Figures 1-12.

A second embodiment of the present invention is recited in claim 16 wherein one of the surfaces has a nonrectangular aspect that is depicted and exemplified in Figure 9.

A third embodiment of the present invention is recited in claim 19 of a wall unit form including a volume which will produce an integral footing when filled that is depicted and exemplified in Figure 4.

The combination of a wall unit form 10 and a wall formed inside therein according to the present invention is exemplified in claim 15, which recites a first surface, formed by an interior surface of a first wall panel 12, a second surface operatively attached to said first surface, said second surface formed by an interior surface of a second wall panel 14, and end surfaces 16, 18 operatively attached to said first and second surfaces thereby forming an upright form 10 and opposing sides, said end surfaces formed by interior surfaces of end wall panels (see, e.g., pages 6-11 of the instant specification for detailed description of the wall unit structure embodied in the claims). The combination further includes wherein at least one of said first, second and end surfaces horizontally supports a plurality of irregularly-shaped discrete veneer components 26 stacked vertically from the ground surface up against at least one panel 12, 14, 16, 18, wherein the wall is formed during a single pour application of a binding material to the wall unit form 10 (see, e.g., pages 11-13 of the instant specification for detailed description of the veneer components embodied in the claims). The combination further requires wherein at least one of said first 12, second 14 and end panels 16, 18 is configured to be removably attached from one another to facilitate entry into a volume defined by the upright form, wherein said entry allows for placement of said plurality of irregularly-shaped discrete components 26 is best depicted in Figures 1 and 9.

Dependent claim 16 is directed toward a second embodiment of the invention as supported by pages 6-11 of the instant specification. In summary, the embodiment is directed toward a nonrectangular wall unit and form as depicted in Figure 9.

Dependent claim 19 is directed toward a second embodiment of the invention as supported by pages 6-11 of the instant specification. In summary, the embodiment is directed toward a nonrectangular wall unit and form as depicted in Figure 4.

(vi) Grounds of rejection to be reviewed on appeal

Issue 1— Whether claims 15-21 are patentable under 35 U.S.C. 112, first paragraph with the term “horizontally supports?”

Issue 2— Whether claims 15-21 are patentable under 35 U.S.C. 112, second paragraph with the term “horizontally supports?”

Issue 3— Whether claims 16 and 17 are patentable under 35 U.S.C. 103 over USPN 6,032,424 to Dial, Jr. in view of USPN 3,116,570 to Torricelli?

Issue 4— Whether claims 16 and 17 are patentable under 35 U.S.C. 103 over USPN 1,809,504 to Carvel in view of USPN 3,116,570 to Torricelli?

Issue 5— Whether claims 15, 19 and 20 are patentable under 35 U.S.C. 103 over USPN 6,032,424 to Dial, Jr. in view of USPN 5,836,572 to Sugiyama?

Issue 6— Whether claims 15 and 18-20 are patentable under 35 U.S.C. 103 over USPN 1,809,504 to Carvel in view of USPN 5,836,572 to Sugiyama?

Issue 7— Whether claims 19 and 21 are patentable under 35 U.S.C. 103 over USPN 6,032,424 to Dial, Jr. in view of USPN 5,836,572 to Sugiyama and further in view of USPN 5,511,761 to Schultz?

Issue 8— Whether claims 19 and 21 are patentable under 35 U.S.C. 103 over USPN 1,809,504 to Carvel in view of USPN 5,836,572 to Sugiyama and further in view of USPN 5,511,761 to Schultz?

Issue 9— Whether claims 16 and 17 are patentable under 35 U.S.C. 103 over USPN 6,032,424 to Dial, Jr. in view of USPN 5,836,572 to Sugiyama and further in view of USPN 3,116,570 to Torricelli?

Issue 10— Whether claims 16 and 17 are patentable under 35 U.S.C. 103 over USPN 1,809,504 to Carvel in view of USPN 5,836,572 to Sugiyama and further in view of USPN 3,116,570 to Torricelli?

(vii) Argument

Prior to discussing each art rejection appearing below as Issues 1 and 2, appellant would first like to bring to the Board’s attention the following specific statement made by the Patent Examiner with respect to each art rejection:

Accordingly, it would have been obvious and well within the skill of one with ordinary skill in the art at the time the invention was made to modify the wall unit form of Dial or Carvel to include a non-rectangular aspect or curved wall panel design(s) in order to enable creation of correspondingly shaped non-rectangular construction units since non-rectangular construction units were notoriously old and well known in the art, as exemplified by Torricelli. (Emphasis added) (Office Action pg. 6, mailed 07/13/2006)

The Examiner uses an improper standard of obviousness when considering the age of the cited art when arriving at a conclusion of obviousness. The proper standard is whether the teaching of the references would motivate one skilled in the art to produce the claimed invention, not whether they were notoriously old and well known in the art. The mere presence of an element or the ease to one skilled in the art to modify the art to add the claimed feature of the combination is not proper, only whether the teaching of the references would motivate one to produce the claimed invention. The court of Appeals for the Federal Circuit has suggested that the standard be “teaching, suggestion or motivation.” See (*Teleflex Inc. v. KSR International* No. 04-1152 (Fed. Cir. 2006) (Cert. Acctp.)) Based on this standard no teaching, motivation or suggestion is present in the paragraph.

Grouping of Claims

For each ground of rejection which appellant contests herein which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

Issue 1—Whether claims 15-21 are patentable under 35 U.S.C. 112, first paragraph with the terms “horizontally supports,” “irregularly-shaped discreet veneer components,” “from the ground up,” and “curvilinear edges”?

The Examiner rejected claims 15-21 for using the terms “horizontally supports,” “irregularly-shaped discreet veneer components,” “from the ground up,” and “curvilinear edges,” which the Examiner alleges to be new matter and not supported as originally filed by the specification. However, Applicant insists that the term “*horizontally supports*” the veneer components is shown in the drawings as each of the stacked veneer components are supported horizontally by the wall unit form (prevented from tipping over) as shown in FIG. 1. The dictionary definition of the term horizontally means “parallel to the horizon or to a base line.” Therefore, the veneer components are supported “parallel to the horizon or to a base line” of the wall unit form and thus horizontally supported.

The term “from the ground up” referring to the stacked veneer components is inherently present in a wall formed standing upright in place at the final position of the wall where the specification states on page 12 that “*individual stones are placed along the bottom of at least one side panel, successive layers of stones are stacked upon the initial layer, thereby forming a stone veneer 26.*”

The term “irregularly-shaped discreet veneer components” is supported in FIG. 9 where the view shows the irregularly shaped pieces, which must inherently be “stacked from the ground up” with an upright form since all the components rest upon previously set components. The term “curvilinear edges” is also shown in FIG. 9 showing the curved edge, which are inherently described in the drawing as the curved edge of the wall.

In support of such submittal Applicant points out Section 2163.07(a) of the MPEP, which reads:

2163.07(a) Inherent Function, Theory, or Advantage

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). **"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.** Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."*"* *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). (Emphasis added)

The claim language "horizontally supports" is inherently supported and **necessarily present** by Figures 1 and 9 and the totality of the teaching of the specification regarding stacking of the veneer components against the panel. Therefore the addition of the term "horizontally supports" to the claims and the specification should not be considered new matter. Rather, the specification has been amended to describe the features that are supported and originally present in the drawings. The drawings are part of the original description and thus the specification can be amended to describe features present in the original drawings and not present new matter.

The MPEP states that:

2163.07 Amendments to Application Which Are Supported in the Original Description [R-3]

Amendments to an application which are supported in the original description are NOT new matter.

I. REPHRASING

Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). The mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter. If there are multiple definitions for a term and a definition is added to the application, it must be clear from the application as filed that applicant intended a particular definition, in order to avoid an issue of new matter and/or lack of written description. See, e.g., *Scarring Corp. v. Megan, Inc.*, 222 F.3d 1347, 1352-53, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000). In *Scarring*, the original disclosure drawn to recombinant DNA molecules utilized the term "leukocyte interferon." Shortly after the filing date, a scientific committee abolished the term in favor of "IFN-(a)," since the latter term more specifically identified a particular polypeptide and since the committee found that leukocytes also produced other types of interferon. The court held that the subsequent amendment to the specification and claims substituting the term "IFN-(a)" for "leukocyte interferon" merely renamed the invention and did not constitute new matter. The claims were limited to cover only the interferon subtype coded for by the inventor's original deposits.

Applicant also has amended the specification to include the re-phrased definition of the irregularly shaped veneer as a veneer that is "lacking perfect symmetry or evenness." The definition of irregularly shaped is not new matter as it merely describes the veneer component shown in FIG. 9 that would be understood by one skilled in the art merely by viewing the drawing. Accordingly, the specification has been amended and it fully supports the claim terms for the reasons of inherency and rephrasing of supported subject matter. Thus, Applicant respectfully requests reconsideration and removal of the rejections under 35 U.S.C. 112 of claims 15-21 in light of the amendments.

Issue 2– Whether claims 15-21 are patentable under 35 U.S.C. 112, second paragraph with the terms “horizontally supports,” and “curvilinear edges”?

Claims 15-21 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that subject matter which applicant regards as the invention. The Examiner finds the term “*horizontally supports a plurality of . . . discrete veneer components*” to be indefinite. However, the term is clearly supported by Figure 1 and the specification. Just as one skilled in the art understands that a table **vertically supports** an object by raising it off the ground preventing it from falling whereas the wall surfaces “*horizontally supports a plurality of irregularly-shaped discreet veneer components stacked vertically from the ground surface up against at least one panel*” thus preventing the veneer components from tipping over (horizontally moving) by leaning against the upright panel.

The veneer components are **vertically supported** by the ground and each of the underlying veneer components that were previously stacked. The surfaces of the wall unit form provides **horizontally supports** for the stacked veneer components and stop them from tipping over before the wall unit form is filled with binding material. One skilled in the art has ample guidance after reading the plain meaning of the claim in light of the enclosed Figure 1. As such, the term “horizontally supports” is not indefinite as it is shown in the drawings and the configuration of the veneer components is described in the specification.

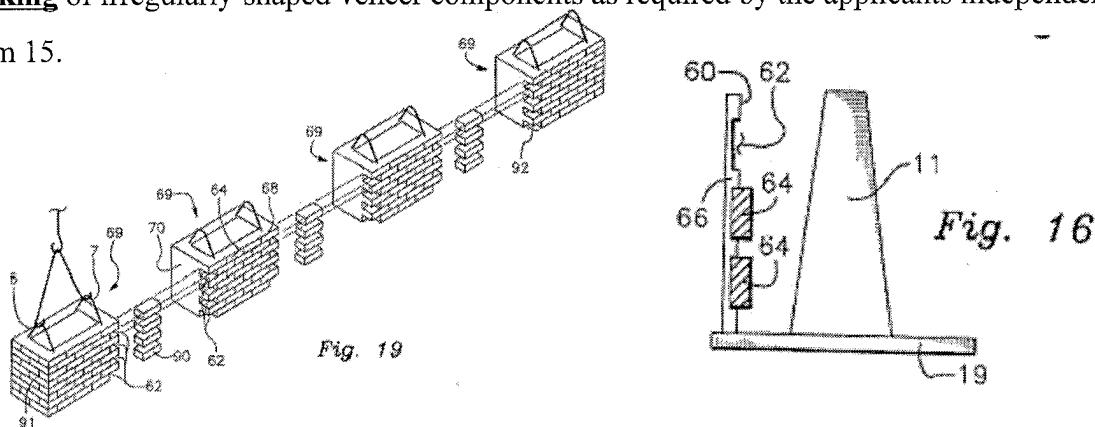
In addition, the specification has been amended to point out that element 68 is curvilinear. Curvilinear is defined in the dictionary as an object bounded by curved lines, which is shown in element 68 that is on the curved edge of the wall and therefore not new matter. If required Applicant will amend the specification to include the dictionary definition of curvilinear, which is not new matter as it was present and possessed by the inventor at the time of filing. One skilled in the art would understand from a review of the drawings, the specification and the claims that the term curvilinear refers to objects bounded by curved lines and thus the term is not indefinite. Hence, Applicant respectfully requests reconsideration and removal of the 35 USC 112, paragraph two rejection of claims 15-21.

Issue 3—Whether claims 16 and 17 are patentable under 35 U.S.C. 103 over USPN

6,032,424 to Dial, Jr. in view of USPN 3,116,570 to Torricelli?

Independent claim 15 recites a combination of a wall unit form and wall formed inside. The wall unit form comprises a first surface, a second surface and end surfaces that are operatively attached to each other in an upright position. The wall is produced within the wall unit form where at least one of the surfaces has a plurality of irregularly-shaped discreet veneer components stacked vertically from the ground surface up against at least one panel. At least one panel is configured to be removably attached to another panel to allow entry to place the discreet components. A binding material is added to the wall form to produce a wall within the wall unit form. Claim 16 includes all the limitations of independent claim 15 and the further limitation that at least one surface has a nonrectangular aspect. Claim 17 includes the limitations of independent base claim 15 and the further limitation that at least one surface has curvilinear edges.

Contrary to the claims of the Applicant's invention, the Dial, Jr. '424 patent teaches the formation of a small block having surface features retained in holes 62. The '424 patent teaches the insertion of rectangular bricks into holes within the face of the mold, but it does **NOT** teach using "*irregularly-shaped veneer components stacked from the ground up*" as required in base claim 15. The '424 patent teaches at col. 8, ln. 10 that "*as can best be seen by references to FIGS. 15 and 16, the interior surface 60 of the outside mold wall 66 defines block openings 62. These block openings 62 may receive brick facing 64 or may be left empty to give texture to the block exterior face 68, shown in FIG. 19.*" (Emphasis added) The '424 patent teaches away from **stacking** of irregularly-shaped veneer components as required by the applicants independent claim 15.



Moreover, Figures 16 and 19 presented above show that the surface veneer components are rectangular shaped and thus NOT irregular shaped and placed into openings 62 of mold surface 66 that correspond to the rectangular components and thus are vertically spaced apart and NOT stacked as clearly shown in FIG. 16 above.

Furthermore, the '424 patent does not teach a panel that is "*configured to be removably attached from one another to facilitate entry into a volume defined by the upright form, wherein said entry allows for placement of said plurality of irregularly-shaped discrete components.*" The '424 patent may allow removal of the form, but not its removal to facilitate placement of irregularly-shaped discreet components because no stacking occurs. The only veneer components taught are rectangular bricks positioned within the pockets 62 in the face of the mold face. Thus the '424 patent does NOT teach being opened for placement by stacking because the bricks are placed in the pockets 62, prior to mold assembly because of the SMALL size of the wall unit that is then stacked in a fashion similar to a brick to form a wall.

Furthermore, the Torricelli '570 patent teaches molded interlocking wall blocks, it does not teach the inclusion of surface veneer feature. While, the '570 patent discloses a curved surface, but it provides no motivation to one skilled in the art regarding "*irregularly-shaped veneer components stacked from the ground up.*" The curved edge of the '570 patent is formed by the binding material and has a surface that is free of "*irregularly-shaped veneer components stacked from the ground up.*"

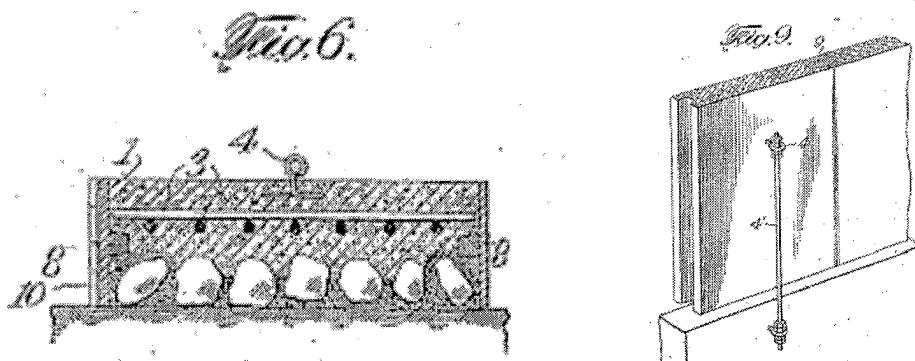
In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), the court held that "*[i]n procedures before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art . . . The patent applicant may then attack the Examiner's prima facie case determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness.*" The combination of the Dial '424 and the Torricelli '570 patents as shown above fails to teach each and every element of base claim 15. The combination of references are silent regarding a wall having a surface of "*irregularly-shaped veneer components stacked from the ground up.*" The omission of the irregularly-shaped veneer component in the combination fails to form a

prima facie case of obviousness. Applicant therefore respectfully requests reconsideration and removal of the obviousness rejection for failing to teach each and every element of claims 16 and 17 as required by patent law.

Issue 4—Whether claims 16 and 17 are patentable under 35 U.S.C. 103 over USPN 1,809,504 to Carvel in view of USPN 3,116,570 to Torricelli?

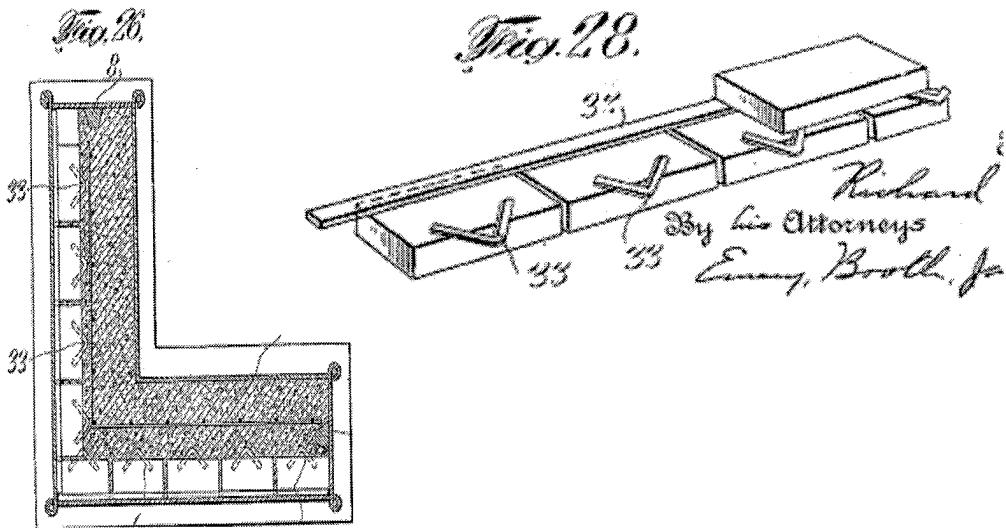
Independent claim 15 recites a combination of a wall unit form and wall produced inside after the addition of binder. The wall unit form comprises a first surface, a second surface and end surfaces that are operatively attached to each other in an upright position. The wall is produced within the wall unit form where at least one of the surfaces has a plurality of irregularly-shaped discreet veneer components stacked vertically from the ground surface up against at least one panel. At least one panel is configured to be removably attached to another panel to allow entry to place the discreet components. A binding material is added to the wall form to produce a wall within the wall unit form. Claim 16 includes all the limitations of independent claim 15 and the further limitation that at least one surface has a nonrectangular aspect. Claim 17 include the limitations of independent base claim 15 and the further limitation that at least one surface has curvilinear edges.

The Carvel '504 patent teaches forming a wall unit producing a wall with "*irregularly-shaped veneer components*" ONLY when the wall is produced laying face down on the ground with the "*irregularly-shaped veneer components*" vertically supported by the ground (wall face down) as shown in FIG. 6. The wall having "*irregularly-shaped veneer components*" is then propped upright and held standing with the assistance of a rod 4 as shown in FIG. 9.



Furthermore, the Carvel '504 patent wall unit form and the wall produced within having an "irregularly-shaped veneer" does NOT teach using the applicant's claimed "first wall panel" or "second wall panel" as required because it is formed against the ground and the panels are not required and therefore not present. The "irregularly-shaped veneer" as shown above clearly in Fig. 6 is NOT stacked against at least one panel, but is laid horizontally side-by-side and then physically propped up. The wall produced may not be as structurally sound or stable as the applicant's claimed wall because it is not vertically stable before binding material is added and can more easily collapse if the binding material is deficient in any manner after being placed in an upright position. Moreover, raising the wall may require use of heavy lifting equipment.

Additionally, the wall unit form and wall formed inside having an "irregularly-shaped veneer" as claimed by the Applicant can have the "irregularly-shaped veneer" on both sides or even all sides, whereas the '504 patent ONLY allows "irregularly-shaped veneer" on one side to enable attachment of the fastening by rod 4 to the support the wall upright. Furthermore, the '504 patent thus teaches one embodiment of a wall having an "irregularly-shaped veneer" built face down and limited to features ONLY on one side. The "irregularly-shaped veneer" is not stacked vertically, but propped into position and secured by rods and other fixtures.



The ‘504 patent teaches a second embodiment using regular rectangular shaped bricks stacked upon each other from the ground up shown above, but one skilled in the art would only be motivated to look toward the solution provided in the first embodiment when building a wall having an “*irregularly-shaped veneer*” and would NOT be motivated to combine the two separate embodiments of wall unit forms having walls formed inside without further guidance.

The Carvel ‘504 patent teaches the formation of a wall in an upright fashion ONLY when REGULAR geometric units are stacked, as shown in FIGs. 26 and 28. In contradistinction, Applicant claims “*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*” Moreover, the second embodiment of FIGs. 26 and 28 shown above is first stacked vertically and then the form is placed around to allow the binding material to be poured into the wall unit form, but it is NOT placed against (leaned against) at least one panel as is required with independent claim 15. In addition, the upright formed wall of the ‘504 patent uses rectangular bricks being stacked and spaced by spacer elements 32 and 33. Thus the regular shaped bricks are vertically supported by the spacers otherwise the binder will not sufficiently adhere to the veneer of the ‘504 patent.

The Torricelli ‘570 patent teaches the production of molded interlocking wall blocks and is silent regarding an “*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel*” as discussed above. The combination of the Carvel ‘504 and the Torricelli ‘570 patent fails, to teach each and every element of independent base claim 15 because one skilled in the art would NOT be motivated to produce an upright standing wall having “*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel*” when the teachings of the references are combined.

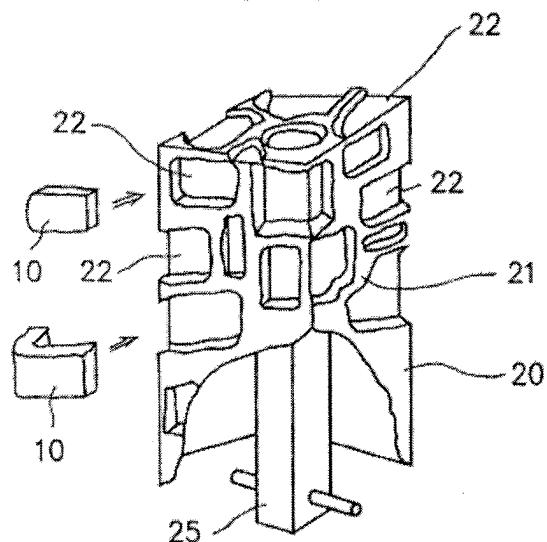
In *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 223 USPQ 603, 609-610 (Fed. Cir. 1984), the court held that “*the proper approach to the obviousness must start with the claimed invention as a whole . . . It is true that it consists of a combination of old elements so arranged as to perform certain related functions. It is immaterial to the issue, however, that all of the elements were old in other contexts. What must be found obvious to defeat the patent is the claimed combination.*” The Examiner suggests in the rejection that the age of the references and the ease of one skilled in the art to modify the references when using the claim as a template

is sufficient evidence of motivation to produce the claimed invention this reasoning is improper. Regardless, the combination of the '504 and 570 patent references fails to teach each and every element of independent claim 15 even if one skilled in the art was motivated to combine the references. One skilled in the art would not be motivated to stack irregularly shaped veneer components against an upright panel without providing teaching to counter that provided by the manner taught in the '504 patent. Hence, the rejection of claims 16 and 17 should be removed as each and every element is not taught by the combination of the references, which fails to form a *prima facie* case of obviousness.

Issue 5—Whether claims 15, 19 and 20 are patentable under 35 U.S.C. 103 over USPN 6,032,424 to Dial, Jr. in view of USPN 5,836,572 to Sugiyama?

Independent claim 15 recites a combination of a wall unit form and wall produced inside after the addition of binder. The wall is produced within the wall unit form where at least one of the surfaces has a plurality of irregularly-shaped discreet veneer components stacked vertically from the ground surface up against at least one panel. Claim 19 includes the feature of an integral footing produced when the mold is filled. Claim 20 includes the feature of a pocket structure in at least one surface formed when the mold is filled.

FIG. 2



The Sugiyama '572 patent, as shown above in FIG. 2, teaches in the abstract and throughout the patent the following:

Artificial stones (10) are molded in a predetermined number of different shapes and a substrate (20) is expansion-molded from foam plastics. Artificial stone receiving recesses (22) are molded integrally with the substrate (20) so as to be paired with the respective artificial stones (10). The artificial stones (10) are adhesively inserted into the corresponding receiving recesses (22) so that such insertion may serve to provisionally prevent the artificial stones (10) from scaling off or falling off before setting of adhesive agent. A protruding rib (21) bordering and defining the respective artificial stone receiving recesses (22) serves also as a joint base adapted to support the overlying joint mortar (23). In this manner, adhesive fixation of the artificial stones (10) is facilitated, on one hand, and weight reduction of the gate post (A) is achieved by employing foam plastics as material for the substrate (20), by making the protruding rib (21) serving also the joint base supporting the overlying joint mortar (23) consequently by saving an amount of the joint mortar (23) to be used. (Emphasis added)

The '572 patent teaches a wall unit form and a wall having receiving recesses 22 that are preformed and shaped to receive the irregularly-shaped artificial stones 10 that are later inserted and glued into the receiving recess 22 AFTER removal of the wall unit form. The '572 patent teaches away from Applicant's invention and does NOT teach a wall having "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel*" as required by applicant's independent claim 15. As shown above the irregularly-shaped veneer of the '572 patent is glued with adhesive into receiving recesses 22.

Furthermore, the '572 patent teaches, at column 4, line 30, that "*the artificial stone receiving recesses 22 are molded integrally with the substrate 20 which is also made of foamed plastics.*" Thus it is only the recesses that are formed after the mold is filled and absent a veneer component. Therefore, the '572 patent does NOT teach "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel*" because there are no veneer components present BEFORE the addition of binding material to form the wall. Additionally, the veneer components could not be **stacked** against the wall unit form as taught because the presence of projections to form the receiving recesses 22 would interfere. Additionally, the wall unit form would NOT be taught to be reattached after the irregularly-

shaped veneer components are glued into the receiving recesses 22 forming the claimed invention.

The Dial, Jr. '424 patent, as discussed above, also does NOT teach a wall unit having "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*" The Dial, Jr. '424 patent also teaches in column 8, line 10 that "*as can best be seen by reference to FIGS. 15 and 16, the interior surface 60 of the outside mold wall 66 defines block openings 62. These block openings 62 may receive brick facing 64 or may be left empty to give texture to the block exterior face 68, shown in FIG. 19*" (emphasis added) Therefore one skilled in the art when applying the teaching of the '424 patent would NOT be motivated to include the "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel,*" but would rather be lead to the production of an opening in either the wall mold or the wall to accept the standardized veneer component.

In *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593, 1595-96 (Fed. Cir.) Cert. denied, 481 U.S. 1052 (1987), the Federal Circuit held:

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principals or features The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole."

The Dial, Jr. '424 patent and the Sugiyama '572 patent were selected merely based on parts on a list not the combination of teachings, which the court has held is insufficient to form a proper rejection. The cited combination of references fails to teach a wall having "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*" At the best, the combination of the teachings of the references produces a wall having irregular recesses molded into the wall having components glued after form removal, but NEVER would there be a wall having "*irregularly-shaped veneer components stacked vertically*

from the ground surface up against at least one panel.” If one skilled in the art were to combine the teachings of the aforementioned references it would likely result in a mold a having a receiving recess to accept a mass produced veneer component, but NEVER would one skilled in the art produce the applicant’s claimed invention with resorting to improper hindsight reasoning based on the Applicant’s disclosure. Hence, Applicant respectfully requests that the rejection of claims 15, 19 and 20 be reconsidered and withdrawn for failing to teach each and every element of independent claim 15.

Issue 6—Whether claims 15 and 18-20 are patentable under 35 U.S.C. 103 over USPN 1,809,504 to Carvel in view of USPN 5,836,572 to Sugiyama?

Independent claim 15 recites a combination of a wall unit form and wall produced inside after the addition of binder. The wall is produced within the wall unit form where at least one of the surfaces has a plurality of irregularly-shaped discreet veneer components stacked vertically from the ground surface up against at least one panel. Claim 18 includes hinged panels for access without removal of the panel from the wall unit form. Claim 19 includes the feature of an integral footing produced when the mold is filled. Claim 20 includes the feature of a pocket structure in at least one surface formed when the mold is filled.

The Carvel ‘504 patent teaches forming a wall unit with “*irregularly-shaped veneer components*” arranged **horizontally** with the wall surface facing the ground, not stacked as admitted by the examiner (pg.6, Final Office action mailed 07/13/06). The Carvel ‘504 patent teaches the formation of a wall in an upright fashion ONLY when regular geometric units are vertically aligned using special spacers NOT the applicants claimed “*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel*” as required in the Applicant’s claims.

The Sugiyama ‘572 patent teaches formation of receiving recesses 22 produced by the wall forming unit, which then the non-regular shaped mass produced artificial stones 10 are inserted into the receiving recess 22. The Examiner selectively chooses that the ‘572 patent teaches the use of irregular-shaped veneer components and then ignores all of the other

teachings. The '572 patent does NOT teach a wall having "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel*" as required by claim 15. The '572 patent teaches at column 4, line 30 that "*the artificial stone receiving recesses 22 are molded integrally with the substrate 20 which is also made of foamed plastics.*" The '572 patent therefore DOES NOT teach "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel,*" but a molded receiving recess having mass produced artificial stone to be adhered to recesses.

In re Wood, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) the Court held that "[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference . . . rather, we look to see whether the combined teachings render the claimed subject matter obvious." The combination of the teachings of the '504 patent and the '572 patent would not provide the applicant's claimed invention because the '572 reference does not teach the irregular veneer structures as claimed by Applicant.

The Court held that "*to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.*" (See *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). If one skilled in the art produced an upright wall as taught by the '504 patent it would have the receiving recesses of the '572 patent where mass produced identical inserts (pre-molded and identical for inserting into the recess) would be installed with adhesive to the formed wall. Regardless, neither of the cited reference teaches vertical stacking of irregularly-shaped veneer objects against a panel, which is then formed into a wall. In view of the above mentioned deficiencies in the combination of references in forming the *prima facie* case of obviousness Applicant respectfully requests reconsideration and removal of the rejection of claims 15 and 18-20.

Issue 7– Whether claims 19 and 21 are patentable under 35 U.S.C. 103 over USPN 6,032,424 to Dial, Jr. in view of USPN 5,836,572 to Sugiyama and further in view of USPN 5,511,761 to Shultz?

Independent claim 15 recites a combination of a wall unit form and wall produced inside after the addition of binder. The wall is produced within the wall unit form where at least one of the surfaces has a plurality of irregularly-shaped discreet veneer components stacked vertically from the ground surface up against at least one panel. Claim 19 includes the feature of an integral footing produced when the mold is filled. Claim 21 includes the feature of an integral-footing-producing volume having radiused corners.

The Shultz '761 patent teaches the formation of an integral footing, but it is silent regarding the use of "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*" Moreover, the '761 patent is silent regarding the use of any surface feature of the wall. The Dial, Jr. '424 patent as discussed above in detail does not teach the use of an "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*" Additionally, the Sugiyama '572 patent as discussed in detail above also does not teach "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel,*" but a preformed veneer component glued to a receiving recess.

In *McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001) the Federal Circuit held that "references that teach away cannot serve to create a prima facie case of obviousness. . . If references taken in combination would produce a seemingly inoperative device, we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness." The aforementioned combination therefore teaches away from the required element of independent claim 15 of having an "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*" The '504 patent teaches REGULAR shaped veneer to be placed into opening in the mold and the '572 patent teaches receiving recesses (openings) that are molded to accept mass produced veneer components, but neither of the teachings would allow the irregularly-

shaped veneer to be stacked from the ground up against a panel of either patent. Applicant respectfully requests reconsideration and removal of the rejection of claims 19 and 21 for failing to form a *prima facie* case of obviousness.

Issue 8– Whether claims 19 and 21 are patentable under 35 U.S.C. 103 over USPN 1,809,504 to Carvel in view of USPN 5,836,572 to Sugiyama and further in view of USPN 5,511,761 to Shultz?

Independent claim 15 recites a combination of a wall unit form and wall produced inside after the addition of binder. The wall is produced within the wall unit form where at least one of the surfaces has a plurality of irregularly-shaped discreet veneer components stacked vertically from the ground surface up against at least one panel. Claim 19 includes the feature of an integral footing produced when the mold is filled. Claim 21 includes the feature of an integral-footing-producing volume having radiused corners.

The Shultz ‘761 patent teaches an integral footing, but it is silent regarding the use of “*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*” The Carvel ‘405 patent and the Sugiyama ‘572 patent, as discussed in detail above, does not teach “*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*” The aforementioned combination therefore fails to teach the required element of independent claim 15 of having an “*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*”

In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) the Federal Circuit held that “it is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” Applicant contends that the rejection is improper because the references weren’t chosen for their teaching, but for their individual elements since the ‘572 patent teaches away from Applicant’s invention. As discussed above, the combination of the references fails to teach each and every element of

the claimed invention and fails to form a *prima facie* case of obviousness. Thus, applicant respectfully requests reconsideration and removal of the rejection of claims 19 and 21.

Issue 9—Whether claims 16 and 17 are patentable under 35 U.S.C. 103 over USPN 6,032,424 to Dial, Jr. in view of USPN 5,836,572 to Sugiyama and further in view of USPN 3,116,570 to Torricelli?

Independent claim 15 recites a combination of a wall unit form and wall produced inside after the addition of binder. The wall is produced within the wall unit form where at least one of the surfaces has a plurality of irregularly-shaped discreet veneer components stacked vertically from the ground surface up against at least one panel. Claim 16 includes at least one surface has a non-rectangular aspect. Claim 17 include the limitations of independent base claim 15 and the further limitation that at least one surface has curvilinear edges.

The Toricelli '570 patent teaches a curved surface, but is silent regarding the use of "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*" The Dial, Jr. '424 patent teaches a small block with the placement of regular-shaped veneer in the form of rectangular blocks into inserts as discussed above and therefore it is also silent regarding either stacking or irregularly-shaped veneer components. The Sugiyama '572 patent as discussed in detail above teaches the formation of receiving recesses in the wall wherein the wall form is removed and standardized veneer inserts are glued into the recesses, but it does not teach "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*"

In *McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) the Federal Circuit held that the "genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references When the art is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously." The Examiner's combination of references teaches away from the invention

and ONLY produces Applicant's claimed invention with the use of hindsight reasoning NOT the teaching of the references. The aforementioned combination fails to teach the required element of independent claim 15 of having an "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*" Hence, Applicant respectfully requests reconsideration and removal of the rejection of claims 16 and 17.

Issue 10— Whether claims 16 and 17 are patentable under 35 U.S.C. 103 over USPN 1,809,504 to Carvel in view of USPN 5,836,572 to Sugiyama and further in view of USPN 3,116,570 to Torricelli?

Independent claim 15 recites a combination of a wall unit form and wall produced inside after the addition of binder. The wall is produced within the wall unit form where at least one of the surfaces has a plurality of irregularly-shaped discreet veneer components stacked vertically from the ground surface up against at least one panel. Claim 16 includes all the limitations of independent claim 15 and the further limitation that at least one surface has a non-rectangular aspect. Claim 17 include the limitations of independent base claim 15 and the further limitation that at least one surface has curvilinear edges.

The Toricelli '570 patent is silent regarding the use of "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*" The Dial, Jr. '424 patent and the Sugiyama '572 patent, as discussed in detail above, also does not teach the required elements of "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*" The aforementioned combination therefore is improper because it fails to teach the required element of independent claim 15 of having an "*irregularly-shaped veneer components stacked vertically from the ground surface up against at least one panel.*" As such, Applicant respectfully requests reconsideration and removal of the rejection of claims 16 and 17.

In *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984), the Federal Circuit held that it was not enough that the reference disclose all the claimed elements in isolation, but "the prior art reference must disclose

each element of the claimed invention arranged as in the claim.” The Sugiyama ‘572 patent teaches a veneer element glued to a receiving recess that is so dissimilar and its teaching so contrary to the Applicant’s invention that it teaches away from the claimed invention. The Examiner cited the ‘572 patent for having an irregular-shaped veneer, but this element is used in isolation of the teaching of the reference and thus improper.

Conclusion

For the extensive reasons advanced above, Appellant respectfully but forcefully contends that each and every claim is patentable. Therefore, appellant prays for reversal of all rejections, which is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any additional shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 19-0513 and please credit any excess fees to such deposit account.

Respectfully submitted,
Schmeiser Olsen & Watts

Date: January 24, 2007

/Jeffrey D. Washville/
Jeffrey D. Washville
Registration No. 46,366

/Arlen L.Olsen/
Arlen L. Olsen
Registration No. 37,543

22 Century Hill Drive, Suite 302
Latham, New York 12110

(viii) *Claims appendix*

15. A combination of a wall unit form and a wall formed inside therein, the combination comprising:

 a first surface, formed by an interior surface of a first wall panel;

 a second surface operatively attached to said first surface, said second surface formed by an interior surface of a second wall panel;

 end surfaces operatively attached to said first and second surfaces thereby forming an upright form and opposing sides, said end surfaces formed by interior surfaces of end wall panels;

 wherein at least one of said first, second and end surfaces horizontally supports a plurality of irregularly-shaped discrete veneer components stacked vertically from the ground surface up against at least one panel, wherein the wall is formed during a single pour application of a binding material to the wall unit form; and

 further wherein at least one of said first, second and end panels is configured to be removably attached from one another to facilitate entry into a volume defined by the upright form, wherein said entry allows for placement of said plurality of irregularly-shaped discrete components.

16. The combination of claim 15, wherein at least one of the first surface, the second surface, and the end surfaces has a nonrectangular aspect.

17. The combination of claim 15, wherein at least one of the first surface, the second surface, and the end surfaces has curvilinear edges.

18. The combination of claim 15, further including said second and said end surfaces being hingedly attached to said first surface.

19. The combination of claim 15, further including a volume which will produce an integral footing when filled.

20. The combination of claim 15, further including a pocket structure operatively attached to at least one of said surfaces.

21. The combination of claim 19, further including an integral-footing-producing volume having radiusued corners.

(ix) Evidence appendix.

None.

(x) Related proceedings appendix

None.